

Remarks

In the Office Action mailed June 26, 2003, the Examiner objected to the drawings.

In addition, the Examiner rejected claims 1-6, 8-11, 17 and 18 under 35 USC § 112, first paragraph for purportedly not complying with the written description requirement.

The Examiner also rejected claims 1-6, 11, 17 and 18 under § 112, first paragraph for alleged lack of enablement.

Additionally, the Examiner rejected claims 11, 17 and 18 under § 112, second paragraph for alleged indefiniteness.

Applicant respectfully requests that in view of the amendments, explanations and controlling authorities cited herein, claim 3 is in condition for allowance. The previously pending claims 1-2, 4-6, 8-11, 17 and 18 have been cancelled, and so the rejections of those claims are moot.

A. Objection to Drawings Has Been Remedied

The Examiner asserted:

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, *the game ball having a cover and a bladder* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application.

Page 2 of the June 26, 2003 Office Action.

Originally filed Figure 1 illustrates a partially peeled away and sectioned portion of a game ball. The designation 16 refers to the cover. The specification has been amended to denote this.

Figure 2, also originally filed, illustrates an example of a game ball, e.g. an American-style football, having a cover 16.

No new matter is added by the amendment to the specification since item 16 is noted as a cover material on page 9 of the application as originally filed.

Figure 1 also illustrates a bladder formed by a layer of air bladder material 12. See page 7, lines 4-6 of the application. Figure 2 illustrates the layer 12 constituting the bladder. The figures illustrate a game ball having a cover and a

bladder. In view of the foregoing, it is respectfully submitted that the objection has been remedied.

Upon allowance of the present application, formal drawings will be submitted.

B. Rejection of Claims 1-6, 8-11, 17 and 18 Under § 112, First Paragraph for Alleged Lack of Written Description Must Be Withdrawn

The Examiner rejected these claims by contending:

Claims 1-6, 8-11, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

*Applicant has failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved during the alleged tanning process for the full range of weight ratios which is critical or essential to the practice of the invention, is not enabled by the disclosure and fails to establish that applicant's original disclosure provides written descriptive support for each of the ratio ranges recited. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). As a result of reviewing and analyzing the specification, which was directed by the Board, it is also now clear an enablement rejection must also be made.*

Applicant has mentioned in the specification (page 10) several suitable leathers, which are commercially available, but has failed to disclose what process has been used to produce the "increase water resistant properties" in the natural leather or that at the time of filing of this application applicant was in possession of this information? Therefore, it is unclear how the unexpected results have been reached, since one skilled in the art will not be able to make or use applicant's invention as originally filed nor is it clear that applicant was in possession of the ratio ranges recited. Additionally, the tables do not correspond to the claimed ranges.

Pages 2-3 of the Office Action (emphasis in original).

Before addressing the Examiner's assertions regarding the extent of written description provided by the present specification, it is instructive to set forth the correct standard for assessing issues involving written descriptions under § 112, first paragraph.

The Court of Appeals for the Federal Circuit pronounced this standard as:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.

In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

The written description requirement is separate and distinguishable from the enablement requirement under § 112, first paragraph. “[W]e hereby reaffirm, that 35 U.S.C. § 112, first paragraph, requires a ‘written description of the invention’ which is separate and distinct from the enablement requirement.” *Vas Cath Inc. v Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

It is unclear why, in support of the present rejection for alleged insufficient written description, the Examiner argues that the claimed invention “is not enabled by the disclosure.” Furthermore, it is unclear why the Examiner cites the decision, *In re Mayhew*. That decision involved issues of whether a specification was enabling.¹

Regardless, it is submitted that for the reasons set forth below, the Examiner will appreciate that the specification provides sufficient written description for the subject matter of claim 3.

Claim 3 as currently pending recites a game ball having increased resistance to moisture absorption. The game ball comprises a natural leather covering disposed over a lining. The leather has increased water resistance properties distributed throughout the cover as a result of a tanning process. The nature of the increased water resistance properties is recited by claim 3 in terms of a maximum amount of water that is absorbed during a particular rain test. Claim 3 expressly recites the parameters of this rain test.

Apparently, the Examiner questions the process by which the “increased water resistant properties for a natural leather cover” are achieved. The Examiner contends that this process is not sufficiently disclosed to satisfy the requirements of § 112, first paragraph.

It is respectfully urged that the present application, as originally filed, does in fact provide the requisite written description for this claimed property:

The leather used in the cover of the ball is prepared by a tanning process and using tanning materials which impart the desired water resistance properties to the leather. The inventors have found that the water resistance properties imparted in the tanning process are longer lasting and provide better water resistance than surface treatments conventionally used on game balls. The water resistance properties imparted by the tanning process are distributed throughout the leather and are associated with each fiber of the leather and not simply on the outer surface of the leather. Because of the distribution of the water resistance properties throughout the leather, water which

¹ The question of why the *Mayhew* case was cited is puzzling, particularly since no explanation or application of that decision was provided by the Examiner.

contacts the leather is typically unable to find an untreated area at which to be absorbed, including the stitching lines between panels, the panel edges and the back or split side of the leather cover. Furthermore, because the water resistance properties are distributed throughout the leather, the properties are not readily susceptible to wearing or washing away, as are the water resistance treatments applied to the surface of other conventional game balls.

Page 5, lines 5-21.

The cover material 16 is formed of a leather which has been tanned by a process using chemicals for imparting water resistance properties to the finished leather. The leather used in the cover of the ball may be one of the type which is traditionally used for such a ball. For example, in an American-style football as shown in Figure 2, the leather would traditionally be a cowhide leather. Similarly, a baseball would also traditionally have a cover made from cowhide leather. However, the actual leather used in the cover of a ball need not be of the traditional type for a particular variety of game ball. For the purposes of this invention, it is more important that the leather used possess the necessary performance properties, including sufficient resistance to water.

The leather used in the present invention is a tanned leather which has substantial water resistance properties imparted by the tanning process and the particular tanning chemicals used in the process. The tanning process imparts water resistance throughout the leather, with all the fibers of the leather acquiring water resistant properties. The tanned-in nature of the water resistance properties makes the leather less likely to absorb water than those leathers which have merely a topical water resistance treatment. The tanned-in water resistance is of particular importance when the ball receives prolonged or multiple exposures to wet conditions.

The water resistance properties of different leathers can be compared in terms of the amount of water absorbed over a period of time by a given size sample of leather. For the purposes of this application, water resistance is expressed as a ratio of the combined weight of a leather sample and the water absorbed after a specific period of immersion in water compared to the original dry weight of the leather sample. It will be appreciated that a sample of leather which has a low ratio, that is, a ratio approaching 1:1, has better water resistance than a sample with a higher ratio.

To achieve the goals of the present invention, the leather used in the game ball should have a ratio of the combined weight of the leather sample and the water absorbed after immersion in water for 45 minutes compared to the original dry weight of the leather sample in the range of 1.01:1 to 1.5:1. Preferably, the ratio should be in the range of 1.02:1 to 1.3:1, and most preferably, 1.05:1 to 1.2:1. Similarly, a football made according to the invention should have a ratio of 1.2:1 or less after 45 minutes of immersion in water.

Leather meeting the requirements of the present invention may be commercially obtained from a leather supplier such as Pittard's, Inc., Leeds, England or Bali Leathers, Inc., Johnston, New York. Specific examples of leathers having waterproofing or water resistance properties which meet the requirements of this invention are available from Pittard's, Inc. under the designations Pittard's WR2000TC and WR100 leather.

Leather tanned using the Pittard's process and chemicals results in a permanent tanned-in water resistance which permeates the leather and imparts water resistance properties to all the fibers of the leather. Leather which is treated in this way is highly resistant to

water in the liquid form, but permits the passage of water vapor through the leather rather freely.

Page 9, line 1 to page 10, line 21.

Applicants provide specific examples of commercially available leathers for use as the leather cover. That is, it is noted that leathers available under the designations WR2000TC and WR100 from Pittard's, Inc. meet the requirements of, and can therefore be utilized in, the claimed subject matter of claim 3.

The Examiner asserts that Applicants have not disclosed the process which imparts the water resistant properties to the leather.

The Examiner is applying a different standard than that which § 112, first paragraph, requires. First, Applicants are not claiming a process for increasing the water resistance properties of a leather. Instead, claim 3 recites a game ball that comprises, in part, tanned leather, that exhibits particular water resistance properties. The specification provides specific examples of commercially available tanned leathers that can be utilized in the claimed game ball. It is repeatedly noted in the quoted passages of the specification that the tanning process of the leather is the process which imparts water resistance properties to the leather. It is also noted that the particular chemicals used in the tanning process impart the water resistance properties to the leather. The specification even notes that it is these "tanned-in" water resistance properties that render the noted leathers suitable for use in the present invention as compared to leathers which merely have a topical water resistance.

The Examiner further argues that the range of weight ratios is not supported by the present specification. Applicants respectfully submit that such support is in fact present.

Independent claim 3 recites that the ball is subjected to six , 45-minute cycles of a rain test. Claim 3 further recites that the ball contains a maximum amount of water, expressed as a ratio of the weight of the ball with absorbed water to the weight of the dry ball, being a maximum of 1.20:1. This is not a range as characterized by the Examiner, but instead a maximum amount of water.

Support is found in the originally filed application for this aspect. It is noted beginning on page 10, line 23 of the application that, "[i]f a game ball of the present invention having a leather cover and a lining is subjected to the 'rain test'...for a period of 45 minutes, the ball would absorb a limited amount of water

which is expressed as the absorption ratio. This ratio is noted as having an upper limit of 1.2:1. See page 11, line 1. Furthermore, the feature of repeated water resistance is described on page 11, lines 8-13. There, this characteristic is described as the ball maintaining an absorption ratio of less than 1.2:1, after six cycles of a 45 minute rain test.

Applying the test pronounced by the Federal Circuit in *In re Kaslow*, it is clear that the disclosure of the present application as originally filed does in fact, reasonably convey to an artisan that the inventors had possession at that time of the subject matter recited in claim 3.

Furthermore, the Examiner's rejection must be withdrawn since claim 3 as now pending parallels claim 3 as originally filed. It is abundantly clear that the disclosure of the application as originally filed demonstrates that the inventors had possession at that time of the subject matter recited in claim 3 as now pending.

In view of the foregoing, the § 112, first paragraph, rejection of claim 3 must be withdrawn.

C. Rejection of Claims 1-6, 11, 17 and 18 Under § 112, First Paragraph, for Purported Lack of Enablement Must Be Withdrawn

The Examiner argued in this regard:

Claims 1-6, 11, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 1-6, the application as originally filed does not provide support for a game ball without a bladder, and for claims 11, 17 and 18, additionally the application as originally filed, does not provide support for a game ball without a lining and without a bladder. The game balls used to conduct the rain test in Example 1 having a cover, a lining and a bladder, and in Comparative Example 1, the game ball having a cover and a bladder. No information has been provided to lead one to believe that additional rain tests were conducted for game balls not having the above characteristics. It is unclear how the claimed ranges were obtained, since there are no tables to support such limitations? Therefore, it is not readily apparent from the claim language that a bladder is present for the claimed game ball.

Regarding claims 11, 17 and 18, claim 11 recites the limitation "three 90 minute cycles of a rain test". Claims 17 and 18 are dependent on claim 11, but both claims 17 and 18 recite the limitation "four 45 minute cycles of a rain test in addition to the limitation of claim 11". There is no support in the disclosure as originally filed, for a game ball being subject first to "three 90 minutes cycles" and then to "four 45 minutes cycles" of the rain test, therefore,

it is unclear how the claimed limitations and ranges were achieved.

Pages 3-4 of the Office Action.

In rejecting claim 3 under § 112 for alleged lack of enablement, the Examiner attempts to ignore or bypass the long recognized standard test for determining whether claimed subject matter is sufficiently enabled by a specification.

The standard for determining whether the specification meets the enablement requirement was set forth in *Mineral Separation v Hyde*, 242 U.S. 261, 270 (1916), as "is the experimentation needed to practice the invention undue or unreasonable?" And, according to § 2164.01 of the MPEP, this standard is "still the one to be applied." See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." See *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988).

Claim 3 recites a game ball comprising in part, a natural leather cover disposed over a lining. Claim 3 encompasses game balls with a bladder and those without a bladder.

On page 4 of the present specification, the types of game balls that may be suited for the present invention are noted:

[A] game ball which includes a lining having water resistant properties over which a leather cover is disposed having water resistant properties. Typically, balls featuring this construction include an air bladder. However, balls of other types of construction (including those made with central cores or centers) may also benefit from use of this invention.

Page 4, lines 12-18.

It is further noted that:

It is envisioned that any game ball can advantageously be constructed according to the present invention including, but not limited to, those game balls traditionally constructed with an outer cover and inner bladder, or optionally, those constructed with a lining disposed between the cover and bladder. Such game balls include, but are not limited to, American-style footballs, rugby balls, soccer balls, volleyballs, and basketballs. It is further envisioned that other leather covered balls may benefit from the present invention, including those balls which have a construction which traditionally features a cover and a core, such as baseballs and softballs.

Page 6, lines 1-10.

The Examiner is taking a position that an artisan in this field of art armed with the present disclosure coupled with information known in the art, would be unable to make the game ball of claim 3 if such game ball did not have a bladder. Moreover, even in the unlikely scenario that the artisan needed to conduct several trials in such a fabrication, the law provides great latitude by qualifying the standard with the requirement that if such experimentation is necessary, it must not be undue.

This ground of rejection is entirely unsupported and must as a matter of law be withdrawn. The Examiner did not submit any evidence or scientific reasoning to support the view that an artisan could not make the claimed game ball without a bladder. The Examiner is respectfully reminded that the MPEP states in this regard, "[t]he examiner should never make the determination [of enablement] based on personal opinion." MPEP § 2164.05, emphasis in original, bracketed test added.

D. Rejection of Claims 11, 17 and 18 Under § 112, Second Paragraph, Must Be Withdrawn

The Examiner contended:

Claims 11, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "three 90 minute cycles of a rain test". However, since claims 17 and 18 are dependent on claim 11, it would also include the limitations of claim 11, but both claims 17 and 18 additionally recite the limitation "four 45 minute cycles of a rain test". There is no support in the disclosure as originally filed, for a game ball being subject first to "three 90 minutes cycles" and then to "four 45 minutes cycles" of the rain test.

Page 5 of the Office Action.

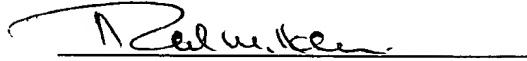
Claims 11, 17, and 18 have been cancelled, and so, this ground of rejection is moot.

E. Conclusion

In view of the amendments and remarks set forth herein, it is submitted that claim 3 is in condition for allowance.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & MCKEE, LLP



Richard M. Klein
Reg. No. 33,000
Mark E. Bandy
Reg. No. 35,788
1100 Superior Avenue
Suite 700
Cleveland, Ohio 44114-2579
(216) 861-5582

N:\RUSS\200007\MAT0000828V001.doc